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09/815,760	03/23/2001	Alan Derek Dean	52308-1190	7939
24504 7590 04/04/2007 THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP 100 GALLERIA PARKWAY, NW STE 1750 ATLANTA, GA 30339-5948			EXAMINER PATEL, HARESH N	
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SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			04/04/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/815,760

Applicant(s)

DEAN, ALAN DEREK

Examiner

Haresh Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/9/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 14-16 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-16 and 18-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>3/20/07</u>                              |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application  |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                           |

### **DETAILED ACTION**

1. Claims 1-12, 14-16 and 18-22 are subject to examination. Claims 13 and 17 are cancelled.

#### ***Response to Arguments***

2. Applicant's arguments, 1/9/2007, with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

#### ***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The present title, i.e., "System for constructing electronic mail addresses" is not sufficient for proper classification of the claimed subject matter (please see the claimed invention, claim 1).

#### ***Drawings***

4. New corrected drawings are required in this application because Figures 1-3 does not show the amended claims, i.e., claimed invention, "instructions operable to collect name and known location data of an individual from an information source; instructions operable to create an at least partial entry for the individual in an index of individuals in a database, the at least partial entry being based on the collected name and known location data of the individual; instructions operable to trigger generation of a standardized electronic mail address for the individual, including: instructions operable to provide a personal name code indicative of the

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name data of the individual, instructions operable to generate an the standardized electronic mail address for said person the individual based on said the personal name code and said the location code; instructions operable to submit the standardized electronic mail address for the individual to the database; and instructions operable to search the database using the personal name code and the location code for the individual to locate the standardized electronic mail address of the individual". Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. A proposed drawing correction or corrected drawings are required in reply to the Office action. The amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled --Replacement Sheet-- in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-12, 14-16 and 18-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter.

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Claim 1 and its dependent claims contain usage of “instructions operable to”, which is not same as “instructions to” and hence do not implement collect, create etc., claimed subject matter, please see claim 1. Also, the instructions of the claimed invention are not encoded in the program of the storage device. Claim 1 and its dependent claims contain “instructions operable to search” that do not produce a concrete and tangible result. It's not until the result of the search is provide to the requesting user that it becomes a tangible result, which enables any usefulness of having done the search to be realized (please see the claimed subject matter of claim 1). Similar applies to claim 7 and its dependent claims, which do not produce a concrete and tangible result. Further, “partial entry” for the individual does not provide any usefulness, which is not used for the generation and/or search. Also, claim 7 contain logic that is not embodied in computer storage medium such as memory. Additional instructions of the dependent claims, for example, claim 21 “instructions operable to determine” are not encoded in the program of the storage device. Additional logic of the dependent claims, for example, claim 22, “logic configured to determine”, are not stored in the computer storage device. Claims 21 and 22 contain limitations that further prevent the independent claims to produce concrete and tangible result.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 1-12, 14-16 and 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps/elements/structural cooperative relationships of

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elements, such omission amounting to a gap between the steps/elements/necessary structural connections. See MPEP § 2172.01. The omitted steps/elements/necessary structural connections are: processing and combining the personal name code and the location code to accomplish the generating of the standardized email address; processing and combining of both the username/identifier portion and hostname/domain name portion of the email address for the generating of the standardized email address; processing including the geographic region information to accomplish the “standardized electronic mail addresses for individuals in a geographic region”; usage of query/request and response to accomplish “providing access”, step utilizing the outcome of the partial entry, query/request to trigger generation of a standardized electronic mail address, storing step to support the search step, and query to initiate the search. Note: without processing both the username portion and the hostname/domain name portion of the email address, it is not possible to generate the standardized email address. Without processing and combining both the username/identifier portion and hostname/domain name portion of the email address, it is not possible to generate the standardized email address. The “standardized electronic mail addresses for individuals in a geographic region” cannot be accomplished without processing including the geographic region information. Without usage of query/request and response it is not possible to accomplish “providing access”. Without query/request it is not possible to trigger generation of a standardized electronic mail address by itself as claimed. Without storing step to retain the email address it is not possible to support the search step. Without query/request it is not possible to initiate the search.

The term "standardized" in the claims 1-12, 14-16 and 18-22 is a relative term, which renders the claim indefinite. The claimed invention does not contain necessary elements for the

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standardized email as compared to a non-standardized email. Also, without having multiple email addresses in the claimed invention, it is not possible to consider uniform addresses (standardized) (multiple) among each other, by just having a single email address.

Claim 1 recites the limitations, “to provide”. These limitations are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim. It is not apparent to whom the personal name code and the location code are provided to, to accomplish the providing. Without having a receiving entity it is not possible to accomplish the providing.

Claim 1 and 7 recite the limitations, “the known location data”, “being”. These limitations are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim as per MPEP rules and guidelines, MPEP 706.03(d). Since, multiple “known location data” exists in the claim, it is not clear which “known location data” is referred by the limitations in the claim.

Claims 2 and 9 recite the limitations, “the family name”. There is insufficient antecedent basis for this limitation in the claim (Please see MPEP 706.03(d)).

Claims 21 and 22 recite the limitations, “the data of the at least partial entry”. There is insufficient antecedent basis for this limitation in the claim (Please see MPEP 706.03(d)).

Claims 21 and 22 recite the limitations, “the data of the at least partial entry in the index is sufficient”, “determined to be insufficient”. These limitations are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim. It is not apparent what data is considered sufficient versus insufficient. Further, these claims do not support which standardized email would be used “to submit” and “to search” of the respective independent claimed limitations. Also it is not apparent how the search of the independent claims would find

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the standardized email address considering that the email address is not generated as per the claimed subject matter of the claims 21 and 22.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-12, 14-16 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agraharam et al., 5,987,508, AT&T Corp., (Hereinafter Agraharam-AT&T) in view of "Official Notice".

9. As per claim 1, Agraharam-AT&T discloses a program storage device readable by a machine and encoding a program of instructions for generating and providing access to a set of standardized electronic mail addresses for individuals in a geographic region (e.g., **usage and handling of email addresses containing telephone number and user name for users including name of the user, family name of the user / various combination of the name and family name and the telephone number, figure 1, col., 5, lines 24 – 58, col., 5, lines 8 – 48, for example, usage of steve's phone number, name and family name in the email address**), said instructions operable to comprising:

instructions operable to collect name and known location data of an individual from an information source (usage of geographical area information, col., 5, lines 8 – 48);



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instructions operable to create an at least partial entry for the individual in an index of individuals in a database, the at least partial entry being based on the collected name and known location data of the individual (usage of database and alias addressing mechanism, directory, registry, col., 6, lines 6 – 67);

instructions operable to trigger having a standardized electronic mail address for the individual, including instructions operable to provide a personal name code indicative of the name data of a person the individual (e.g., usage and handling of email addresses containing telephone number and user name for users, figure 1, col., 5, lines 24 - 58); instructions operable to provide a location code indicative of a the known location data of the individual (e.g., usage and handling of email addresses containing telephone number and user name for users, col., 3, lines 12 - 63); and instructions operable to have the standardized electronic mail address for said individual based on said the personal name code and said the location code (e.g., usage and handling of email addresses containing telephone number and user name for users, figure 1, col., 5, lines 24 - 58),

instructions operable to submit the standardized electronic mail address for the individual to the database (e.g. to the database and alias addressing mechanism, directory, registry, col., 6, lines 6 – 67);

and instructions operable to search the database using the personal name code and the location code for the individual to locate the standardized electronic mail address of the individual (usage of database and alias addressing mechanism, directory, registry, col., 7, lines 8 – 61).

Agraharam-AT&T discloses specifically mention about trigger to generate email address and to generate email address. "Official Notice" is taken that both the concept and advantages of providing trigger to generate email address and to generate email address is well known and expected in the art. Pena, 6,292,211, discloses these well-known claimed limitations, col., 13, lines 39 – 67. Grauman, 6,707,472, discloses these well-known claimed limitations, col., 9, lines 36-45, figure 3. Hall 5,930,479, discloses these well-known claimed limitations, col., 5, lines 1 – 48. Ramey et al., 6,298,128 discloses these well-known claimed limitations, col., 2, lines 28 – 65). Toyoda, 6,897,985, discloses these well-known claimed limitations, col., 5, lines 2-38, col., 6, lines 2 - 26. Oseto 6,9097,797 discloses these well-known claimed limitations, col., 3, lines 2 – 48. Scroggie et al., 5,970,469, discloses these well-known claimed limitations, col., 9, lines 29 –41. Pennell et al., 2005/0125546, discloses these well-known claimed limitations, paragraphs 11 and 12. Dovolis, 2001/0034609, discloses these well-known claimed limitations, paragraph 39, abstract; Pennell et al., 6,874,023, discloses these well-known claimed limitations, paragraph 24; Szutu, 2001/0047391, discloses these well-known claimed limitations, paragraphs 11 and 12. Rudy et al., 6,360,252, discloses these well-known claimed limitations, col., 19, line 5 – 22, line 54 – col., 20, line 23. Yahoo People search, 02/08/1999, <http://people.yahoo.com>, discloses these well-known claimed limitations, pages 1 and 2. Lytle et al., 2003/0120737, Microsoft Corporation, discloses these well-known claimed limitations, paragraph 130. Kasso et al., 6,173,283, discloses these well-known claimed limitations, col., 2, lines 1 – 35. Brezin et al., 7,039,639, discloses these well-known claimed limitations, col., 4, lines 7 – 38. Brown, Nortel Networks Corporation, discloses these well-known claimed limitations, figures 1, 2, col., 4, lines 13 - 26. Kleinberg, 2001/0037265, discloses these well-known claimed limitations, figure 1, col.,

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3, lines 23 - 46. Siitonen et al., 6,049,796, discloses these well-known claimed limitations, abstract. Beck et al., 6,026,371, discloses these well-known claimed limitations, figure 3B, col., 4, lines 23 - 48.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include trigger to generate email address and to generate email address with the teachings of Agraharam-AT&T in order to facilitate usage of the generating of the email address because the generation would provide the email address. The well-known concept of generating email address would provide email addresses that is used for communicating messages from one device to another. The motivation is obvious because without generating of the email address the email address would not exist. Agraharam-AT&T discloses usage and handling of email address that contain phone number with location information along with person's name, family name and/or various combination of the location information, name and family name, which would not exist without the email address being generated prior to the usage of the email addresses.

10. As per claim 7, Agraharam-AT&T discloses the claimed limitations as rejected above. Agraharam-AT&T also discloses a system for generating and providing access to a set of standardized electronic mail addresses for individuals in a geographical region (e.g., figure 1, col., 2, lines 39 - 65), comprising logics configured to implement the above rejected claimed subject matter and a search engine for the rejected searching (e.g., figure 1, col., 2, lines 39 - 65).

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11. As per claims 2, 8, Agraharam-AT&T discloses the claimed limitations as rejected above.

Agraharam-AT&T also discloses wherein the location code is a region specific portion of a telephone number (e.g., col., 5, lines 24 - 58).

12. As per claims 3, 9, Agraharam-AT&T discloses the claimed limitations as rejected above.

Agraharam-AT&T also discloses wherein the personal name code includes at least the family name of the individual (e.g., col., 1, lines 22 - 57).

13. As per claims 4, 10, Agraharam-AT&T discloses the claimed limitations as rejected

above. Agraharam-AT&T also discloses wherein standardized email address is for each individual in geographic region (col., 5, lines 24 - 58).

14. As per claims 5, 11, Agraharam-AT&T discloses the claimed limitations as rejected

above. Agraharam-AT&T also discloses wherein one or more subsidiary addresses, including existing electronic addresses, are associated with the standardized electronic mail address of the individual in the database (e.g., translation server email address and/or alias email address versus actual email address / country code specific address, col., 5, lines 8 - 65).

15. As per claims 6, 12, 16, 20, Agraharam-AT&T discloses the claimed limitations as

rejected above. Agraharam-AT&T also discloses wherein the instructions are further operable to attach an identifier to the standardized electronic mail address of the individual (e.g., col., 5, lines 8 - 65). However, Agraharam-AT&T do not specifically mention about attaching a unique

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identifier to the email address, after determining that the electronic mail address is non-unique.

"Official Notice" is taken that both the concept and advantages of providing attaching a unique identifier to the email address, after determining that the electronic mail address is non-unique is well known and expected in the art. For example, Scroggie et al., 5,970,469, discloses these limitations, creation of unique identification that also includes e-mail address, col., 9, lines 29 - 41; Pennell et al., 2005/0125546, also discloses these limitations, usage of generation of an e-mail address that is having unique information, paragraphs 11 and 12. Dovolis, 2001/0034609, also discloses these limitations, usage of unique e-mail address and/or combination with other unique identifiers, paragraph 39, abstract; Pena, 6,292,211, also discloses these limitations, usage of creating an e-mail address for each subscriber and assigning a unique system access code, col., 13, lines 60 - 67; Pennell et al., 6,874,023, also discloses these limitations, usage of generating an e-mail address with a unique identifier, paragraph 24; Szutu, 2001/0047391, also discloses these limitations, usage of generation of an e-mail address that is having unique information, paragraphs 11 and 12.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include attaching a unique identifier to the person's electronic mail address and after determining that the electronic mail address is non-unique attaching an indicator with the teachings of Agraharam-AT&T in order to facilitate making electronic mail address unique among other electronic mail addresses. By having a unique identifier for each electronic mail address, it would help identify each electronic mail address differently from the other electronic mail addresses. The well-known concept of attaching unique identifier would enhance making distinct email addresses.

16. As per claims 14, 18, Agraharam-AT&T discloses the claimed limitations as rejected above. Agraharam-AT&T also discloses wherein the instructions are further operable to provide the database of electronic mail addresses on-line (e.g., usage of directory assistance / Internet, col., 5, line 38 – 23).

17. As per claims 15, 19, Agraharam-AT&T discloses the claimed limitations as rejected above. Agraharam-AT&T also discloses wherein the instructions are further operable to locate the electronic mail address of the individual in the database (e.g., retrieval from the database / addressing mechanism, col., 6, lines 6 – 67).

18. As per claims 21, 22, Agraharam-AT&T discloses the claimed limitations as rejected above. Agraharam-AT&T also discloses handing of the email address when the data of the at least partial entry is sufficient (usage of database and alias addressing mechanism, directory, registry, col., 6, lines 6 – 67).

### ***Conclusion***

Examiner has cited particular columns and line numbers and/or paragraphs and/or sections and/or page numbers in the reference(s) as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing

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responses, to fully consider the references in entirety, as potentially teaching, all or part of the claimed invention, as well as the context of the passage, as taught by the prior art or disclosed by the Examiner.

Note: The scope of the claimed subject matter of the amended claims dated 1/9/2007 is narrower compared to the claims 5/15/2006, which were rejected by the office action dated 5/15/2006.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (571) 272-3973. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn, can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Haresh Patel

March 28, 2007